

REMARKS

These Remarks are in reply to the Office Action mailed June 28, 2006. Claims 1-61 were pending in the Application prior to the outstanding Office Action.

The Examiner is thanked for extending the courtesy of an interview on Thursday 19th October, 2006 at 2PM PDT. During the interview the Applicant indicated that the Applicant's invention called for a completely deterministic state machine [0016] line 10, whereas Marshall (U.S. Patent App. No. 2003/0070139) hereafter *Marshall*, requires a heuristic assessment, see paragraph [0039] line 6. The Applicant produced definitions of a deterministic state machine as a finite state machine where for each pair of state and input symbols there is one and only one transition to a next state, which the Applicant contrasted with a finite state machine in which behavior is composed of states, transitions and actions (wikipedia.org). The Applicant respectfully submitted that *Marshall* disclosed a finite state machine but not a deterministic state machine. The Examiner did not agree with the Applicant.

Claims 1, 20 and 41 are being amended. The amendment to Claims 1, 20 and 41 introduce limitations supported in the specification at least at paragraphs [0014], [0016], [0019]-[0024], [0030] and [0032]-[0034]. Claims 1-61 remain for the Examiner's consideration. Reconsideration and withdrawal of the rejections are respectfully requested.

CLAIM OBJECTIONS

The Examiner objected to Claims 15 where the word 'and' rather than 'or' was used between 'moving' and 'deleting'.

The Applicant does not agree with the Examiner. The word 'and' is appropriate for indicating alternatives which can be selected from a group as in Claim 15.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-2, 4-13, 16-21, 23-24, 37-42, 44-47, 49-54 and 56-61 are rejected under 35 U.S.C. §102(a) as allegedly being anticipated by *Marshall*.

Amended Claim 1 recites the additional limitation of "generating one or more categorized annotations of the one or more free form annotations based on one or more of anchor types, comment types and connector types where the anchor types, comment types

and connector types are selected from a predetermined set of anchor types, comment types and connector types”. Because this limitation is not disclosed, *Marshall* does not disclose all elements of amended Claim 1.

Amended Claim 20 recites the additional limitation “a categorizing component capable of categorizing the one or more freeform annotations and indicating to the user the category of the one or more free-form annotations”. Because *Marshall* does not disclose this limitation, *Marshall* does not disclose all elements of amended Claim 20.

Amended Claim 41 recites the additional limitation that “categorize the one or more freeform annotations and indicate to a user the category of the one or more free-form annotations”. Because *Marshall* does not disclose this limitation, *Marshall* does not disclose all elements of amended Claim 41.

Amended Claims 1, 20 and 41 also recite the limitation of “processing the one or more freeform annotations via a completely deterministic state machine”. In contrast, *Marshall* requires that “annotations should be analyzed to detect types” and “assess relative values”, *Marshall*, paragraph [0039]. A person having ordinary skill in the art would understand that the numerous annotation types that can be used by ANY user, certainly excludes only ‘one meaning or interpretation’. Depending on the style, an annotation mark may be absent in one document and abundant in another. Thus, not only does a “reader's marking style need to be characterized” but also “the frequency of the reader's marks”, see *Marshall*, paragraph [0038]. The Applicant respectfully submits that the continuum of responses for ‘reader's marking style’ and ‘the frequency of the reader's marks’ precludes processing by a deterministic finite state machine. In order for a reference to anticipate, each and every element as set forth in the claim must be either expressly or inherently described in the reference. MPEP 2131. Because the limitation “processing the one or more freeform annotations via a completely deterministic state machine” is neither expressly nor inherently disclosed, *Marshall* does not disclose all elements of amended Claims 1, 20 and 41.

Because *Marshall* does not disclose all elements of amended Claims 1, 20 and 41, it cannot anticipate amended Claims 1, 20 and 41.

Claims 2, 4-13, 16-21, 23-24, 37-42, 44-47, 49-54 and 56-61 all directly or indirectly depend from independent Claims 1, 20 and 41, and are therefore believed

patentable for at least the same reasons as independent Claims 1, 20 and 41 and because of the additional limitations of these claims.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 102(e) rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 3, 14, 15, 22, 35-36, 43, 48 and 55 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable Marshall (U.S. Patent App. No. 2003/0070139).

Claims 3, 14, 15, 22, 35-36, 43, 48 and 55 all directly or indirectly depend from independent Claims 1, 20 and 41, and are therefore believed patentable for at least the same reasons as independent Claims 1, 20 and 41 and because of the additional limitations of these claims.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 103(a) rejection.

CONCLUSION

In light of the above, it is respectfully requested that all outstanding rejections be reconsidered and withdrawn. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Fees in the amount of \$450.00 are authorized to be charged to Fliesler Meyer LLP Deposit Account No. 06-1325. The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this reply, including any fee for extension of time, which may be required.

Respectfully submitted,

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